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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,954	07/27/2000	Frederick W. Ryan JR.	F-173	9430

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EXAMINER

WOO, RICHARD SUKYOON

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/626,954

Applicant(s)

RYAN, FREDERICK W.

Examiner

Richard Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 28-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26, 28-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

- 1) Applicant's response filed on January 29, 2004 is acknowledged.
- 2) Applicant's arguments with respect to claims 15 and 19 have been considered but are moot in view of the new ground(s) of rejection. The new ground of rejection has been necessitated by the newly added limitation(s) to the respective claim.

- 3) Applicant's arguments have been fully considered but they are not persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references

are directed to the mailing processing system that enables the business mailers to effectively and securely process the mail pieces.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's arguments that Pintsov does not suggest nor teach that the unique identifier is used to generate the postage indicium on the mail piece, Pintsov is cited to provide a high level of security for Stier et al.. Stier et al. discloses the invention comprising: receiving postage indicium information (sensitive data including the postage value) at the postage metering system from the data center; and printing the postage indicium on the business reply mail piece at the postage metering system using the postage indicium information. Although the postage indicium information is encrypted, Stier et al. cannot remedy the potential abuse or waste (such as, the postage indicium can be generated for the wrong destination address or any culprit can steal the roll of postage indicium labels because the indicium may not be in any way associated with a specific address). Pintsov is cited to cure the above cited deficiencies of Stier et al. so as to add the unique identifier feature into the ordinary postage indicium information, for the purpose of providing a high level of security.

4) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

5) Claims 1-2, 4-5, 9-11, 15, 19-20, 28, 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stier et al. (US 6,428,219) in view of Pintsov et al..

W.R.T. Claim 1:

Stier et al. discloses a method of operating a data center (128) for generating postage indicium information for use with printing a postage indicium on a business reply mail piece (col. 4, line 57 – col. 5, line 37; col. 6, lines 26-67; for the mail campaign sender), the method comprising the steps of:

receiving postage indicium information at the postage metering system from the data center (128; see Fig. 10);

printing the postage indicium on the business reply mail piece at the postage metering system (122, 124) using the postage indicium information.

However, Stier et al. does not specifically disclose the method comprising:

transmitting a registration ID number, provided by a mail campaign sender to a user, from the postage metering system to a data center, the registration ID number being associated with a delivery address previously defined by the mail campaign sender.

Pintsov et al. teaches, for a mail processing system and method , that the method comprising:

generating and transmitting a registration ID number, which is corresponding to the delivery address previously defined by the mail campaign sender, to the data center (ID number 202; see Figs. 1-2).

Since Pintsov et al. and Stier et al. are both from the same field of endeavor, the purpose taught by Pintsov et al. would have been well recognized in the pertinent field of Stier et al.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to generate and utilize a registration ID number, which is associated with the delivery address previously defined by the sender, as taught by Pintsov et al. and to further modify the postage indicium information to employ the registration ID number, for the purpose of providing a high level of security against intercept of transmitted mailing lists, identification numbers, other data communicated between the campaign sender and data center (or other party), and the postage indicium fraud or misuse.

W.R.T. Claim 2: The modified Stier et al. further discloses the method, including the steps of: printing the delivery address on the business reply mail piece at the postage metering system (col. 4, line 57 – col. 5, line 37 in Stier et al.), where the delivery address has been selected, by the data center from a plurality of delivery addresses previously defined by the mail campaign sender (see ID number 202; see Figs. 1-2 and the descriptions thereof in Pintsov), according to parameters associated with the user of

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the postage metering system that were previously established by the mail campaign sender (see *Supra* Pintsov).

W.R.T. Claim 4:

Stier et al. discloses a method of operating a data center (128) for generating postage indicium information for use with printing a postage indicium on a business reply mail piece (col. 6, lines 26-67; for the mail campaign sender), the method comprising the steps of:

receiving a delivery address from a mail campaign sender (so as to print the address on the envelope, col. 4, line 57 – col. 5, line 37);

establishing a transaction session with a postage metering system (see Fig. 10);

receiving postage indicium information at the postage metering system from the data center (128; see Fig. 10); and

printing the postage indicium on the business reply mail piece at the postage metering system (122, 124) using the postage indicium information.

However, Stier et al. does not specifically disclose the method comprising:

generating and transmitting a registration ID number, which is corresponding to the delivery address previously defined by the mail campaign sender, to the data center; and

generating the postage indicium information using the registration ID number and including data relating the delivery address.

Pintsov et al. teaches, for a mail processing system and method, that the method comprising:

generating and transmitting a registration ID number, which is corresponding to the delivery address previously defined by the mail campaign sender, to the data center (ID number 202; see Figs. 1-2).

Since Pintsov et al. and Stier et al. are both from the same field of endeavor, the purpose taught by Pintsov et al. would have been well recognized in the pertinent field of Stier et al.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to generate and utilize a registration ID number, which is associated with the delivery address previously defined by the sender, as taught by Pintsov et al. and to further modify the postage indicium information to employ the registration ID number, for the purpose of providing a high level of security against intercept of transmitted mailing lists, identification numbers, other data communicated between the campaign sender and data center (or other party), and the postage indicium fraud or misuse.

W.R.T. Claim 5: The modified Stier et al. further discloses the method including the step of performing address hygiene on the delivery address; and transmitting a hygiened addressed to the sender (see Fig. 7 in Pintsov et al.).

W.R.T. Claim 28: The modified Stier et al. further discloses the method including the steps of:

storing a plurality of delivery addresses previously defined by the mail campaign sender (see Figs. 2-4 and the descriptions thereof in Pintsov et al.); and

selecting the delivery address for the business reply mail piece from the plurality of addresses according to parameters, previously established by the sender (see Id.).

W.R.T. Claim 9:

Stier et al. discloses a method of operating a business reply mail processing system, the method comprising the steps of:

providing a delivery address, associated with a particular mail campaign which includes a business reply mail piece, to a data center (inherently, the delivery address must be provided to the data center so that the delivery address later can be printed on the envelop, col. 4, line 57 – col. 5, line 37);

receiving postage indicium information at the postage metering system from the data center (128; see Fig. 10); and

printing the postage indicium on the business reply mail piece at the postage metering system (122, 124) using the postage indicium information.

However, Stier et al. does not specifically disclose the method comprising:

generating and supplying a registration ID number, which is corresponding to the

delivery address previously defined by the mail campaign sender, to the data center;
and

generating the postage indicium information using the registration ID number and including data relating the delivery address.

Pintsov et al. teaches, for a mail processing system and method , that the method comprising:

generating and supplying a registration ID number, which is corresponding to the delivery address previously defined by the mail campaign sender, to the data center (ID number 202; see Figs. 1-2).

Since Pintsov et al. and Stier et al. are both from the same field of endeavor, the purpose taught by Pintsov et al. would have been well recognized in the pertinent field of Stier et al.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to generate and utilize a registration ID number, which is associated with the delivery address previously defined by the sender, as taught by Pintsov et al. and to further modify the postage indicium information to employ the registration ID number, for the purpose of providing a high level of security against intercept of transmitted mailing lists, identification numbers, other data communicated between the campaign sender and data center (or other party), and the postage indicium fraud or misuse.

W.R.T. Claim 10: The modified Stier et al. further discloses the method including the step of receiving from the data center a new hygiened address representing a version of the delivery address (see Fig. 7 and the description thereof in Pintsov et al.) prior to supplying the registration ID number and the business reply mail piece to the user, wherein the new hygiened address is to be used as the delivery address.

W.R.T. Claim 34: The modified Stier et al. further discloses the method including the steps of: defining a plurality of addresses (see Figs. 2-4 and the descriptions thereof in Pintsov et al.); and establishing parameters for use in determining a selected one of the plurality of delivery addresses (see Fig. 2 for the parameters in Pintsov et al.) to use as the delivery address on the business reply mail piece.

W.R.T. Claim 15:

Stier et al. discloses a memory device assessable by a computing system, the memory device comprising:

a plurality of mail campaign sender accounts associated with respective mail campaign senders (inherently so as to process the business mailpieces, col. 4, line 57 – col. 5, line 37; col. 6, lines 1-57), wherein the postage indicium is printed on the business reply mail piece at the postage metering system (122, 124) using the postage indicium information.

However, Stier et al. does not disclose the memory device including: the each of the plurality of mail campaign sender accounts having a registration ID number

associated with a delivery address and a particular mail campaign of which a business reply mail piece is a part.

Since Pintsov et al. and Stier et al. are both from the same field of endeavor, the purpose taught by Pintsov et al. would have been well recognized in the pertinent field of Stier et al.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to generate and utilize a registration ID number, which is associated with the delivery address previously defined by the sender, as taught by Pintsov et al. and to further modify the postage indicium information to employ the registration ID number, for the purpose of providing a high level of security against intercept of transmitted mailing lists, identification numbers, other data communicated between the campaign sender and data center (or other party), and the postage indicium fraud or misuse.

W.R.T. Claim 36: The modified memory device of Stier et al. further discloses the invention, wherein some of the plurality of mail campaign sender accounts include: a plurality of delivery addresses (see Figs. 2-4 in Pintsov et al.); and parameters for use in determining a selected one of the plurality of delivery address to use as the delivery address on the mail piece (see the parameters in Fig. 2 in Pintsov et al.).

W.R.T. Claim 19:

Stier et al. discloses a mail piece comprising:

a postage indicium generated using a postage indicium information, wherein a delivery address, associated with a particular mail campaign which includes a business reply mail piece, is provided to a data center (inherently, the delivery address must be provided to the data center so that the delivery address later can be printed on the envelop, col. 4, line 57 – col. 5, line 37) and is printed on the mail piece.

However, Stier et al. does not specifically disclose the mail piece comprising:

a registration ID number printed on the mail piece, where the ID number is corresponding to the delivery address previously defined by the mail campaign sender, to the data center; and

the postage indicium generated using the registration ID number and including data relating the delivery address.

Pintsov et al. teaches, for a mail piece comprising:

a registration ID number (306) printed there on (see Figs. 6, 10) and wherein the registration ID number is associated with a mail campaign sender (ID number 202; see Figs. 1-2), a previously defined delivery address (see Figs. 2-3) and a particular mail campaign

Since Pintsov et al. and Stier et al. are both from the same field of endeavor, the purpose taught by Pintsov et al. would have been well recognized in the pertinent field of Stier et al.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to generate and utilize a registration ID number, which is associated with the delivery address previously defined by the sender, as taught by Pintsov et al. and to further modify the reply mail piece of Stier et al. to include the postage indicium generated using the registration ID number, for the purpose of providing a high level of security against intercept of transmitted mailing lists, identification numbers, other data communicated between the campaign sender and data center (or other party), and the postage indicium fraud or misuse.

W.R.T. Claim 20: The modified Stier et al. further discloses the mail piece, wherein the previously defined delivery address is also printed thereon (see Supra Pintsov et al. and Stier et al.).

6) Claims 3, 6, 12, 16, 22, 25, 30-31, 39-40 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stier et al. (US 6,428,219) and Pintsov et al. as applied to Claims above, and further in view of Fredman (US 6,526,393).

The modified Stier et al. discloses the invention as recited above but does not disclose the method including:

receiving a subsidy provided by the data center to the user of the postage metering system for mailing the business reply mail piece; and

providing a notification to the mail campaign sender when the business reply mail piece is posted by the user.

Freedman teaches, for method of mailing or shipping goods using a registration ID number, that the method comprises:

receiving a subsidy provided by the data center to the shipper or user of the postage metering system for mailing the goods; and

providing a notification to the merchant when the mails or goods are posted by the user (when the barcode or ID numbers of the mails or goods are processed and read by reader, the merchant must receive the notification whether the mailpieces or goods are posted).

Since Fredman and Stier et al. are both from the same field of endeavor, the purpose disclosed by Fredman would have been well recognized in the pertinent art of Stier et al.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art, to modify the method of operating a postage metering system such that the user receives a subsidy provided by the data center for mailing the business reply mail piece, as taught by Fredman, for the purpose of improving customer response time, company cash flow and the general likelihood of a recipient's response.

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7) Claims 7-8, 13-14, 17-18, 21, 23-24, 26, 32-33, 35, 37-38, 41 and 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stier et al., Pintsov et al. and Fredman as applied to claims above, and further in view of Allott, III (US 6,121,565).

The modified Stier et al. discloses the method and device as recited above, but does not expressly disclose the invention further comprising:

receiving the subsidy when the business reply mail piece is posted within a specified time period defined by the mail campaign sender; and
providing a warning to for attempting to reply after the expiration date.

Allott, III teaches, for a method of delivery a business reply mail piece using expiring indicia, that the method comprises:

providing a subsidy for mailing the business reply mail piece when the business reply mail piece is posted within a specified time period (see Figs. and summary of the invention);

receiving an expiration date from the mail campaign sender; and
providing a warning to for attempting to reply after the expiration date.

Since Allott and the modified system and method of Stier et al. are both from the same field of endeavor, the purpose disclosed by Allott would have been well recognized in the pertinent art of the modified Stier et al..

Accordingly, it would have been further obvious at the time the invention was made to a person having ordinary skill in the art, to utilize the delivery system using expiring indicia with a manifested time in the modified mail delivery system of Stier et al., as taught by Allott, for the purpose of providing extremely effective method of decreasing the time between billing and remittance by positively reinforcing early return of business reply mail piece.

Conclusion

8) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

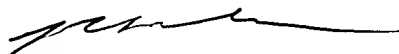
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.



Richard Woo
Patent Examiner
GAU 3629
April 19, 2004



JOHN G. WEISS
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